

Remarks

In the Office Action of July 12, 2004, the Examiner rejected the pending claim under 35 U.S.C. § 103 over U.S. Patent No. 5,034,524 to Shiokawa et al. (“Shiokawa”), and U.S. Patent No. 5,945,445 to Barringer et al. (“Barringer”). The Examiner argued that Shiokawa disclosed agonists or antagonists of the nicotinic acetylcholine receptors of insects in combination with other active compounds such as insecticides. The Examiner also argued that Barringer disclosed avermectin derivatives having insecticidal activity. Therefore, concluded the Examiner, the combination could be expected to be useful as an insecticidal composition.

The Examiner’s argument is respectfully traversed. Even closely related compounds will seldom have identical effects in nature. Thus, one cannot predict from general statements what compounds will work for what purposes. The cited references do not address the limitations set forth in the pending claims, so the rejection should be withdrawn.

Shiokawa prepared forty samples (shown in Table 1 of Shiokawa) of closely related compounds and tested each for activity against green rice leafhopper and *Myzus persicae* (Examples 8 and 9 of Shiokawa). Of these forty samples, only nine were effective against the pests. One skilled in the art cannot necessarily predict activity from one compound to another, even for treatment of a single species. It is just as difficult to predict activity across species lines.

As difficult as it may be to predict activity between different species, it is even more difficult to predict activity across orders, classes or phyla. Neither Shiokawa nor

Barringer discuss fleas. Shiokawa treats plants, yet does not mention the the order Siphonoptera, the order of fleas, in its disclosure of “pests” at col. 4. Line 41 – col. 5, line 53. Barringer looks exclusively to the treatment of pine wilt nematodes. One skilled in the art would simply not look to either reference in the first place, much less a combination of the two references to make a formulation that was effective against fleas.

Even if one were to try and force the two references together, one skilled in the art could only come up with a treatment for pine trees. Barringer is limited to treatment of pine trees, and Shiokawa, while broader than Barringer, primarily contemplates treatment of plants. Thus the combination could not lead one skilled in the art towards the claimed invention.

Allowance of the new claims is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Richard S. Bullitt", with a stylized flourish at the end.

Richard S. Bullitt
Reg. No. 30,733

Bayer HealthCare, LLC
36 Columbia Road
Morristown, NJ 07962